

ESTTA Tracking number: **ESTTA384093**

Filing date: **12/16/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Icebreaker Limited		
Entity	Corporation	Citizenship	New Zealand
Address	Level 2, Hope Gibbons Building 7-11 Dixon Street Wellington, NEW ZEALAND		

Attorney information	James L. Vana Perkins Coie LLP 1201 3rd Avenue Seattle, WA 98101-3099 UNITED STATES pctrademarks@perkinscoie.com Phone:(206) 359-3036
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Registrations Subject to Cancellation

Registration No	1477298	Registration date	02/23/1988
International Registration No.	NONE	International Registration Date	NONE
Registrant	GILMAR S.P.A. 723-725, via Malpasso I-47842 San Giovanni in Marignano, ITALY		

Goods/Services Subject to Cancellation

Class 025. All goods and services in the class are cancelled, namely: MENS' AND WOMENS' CLOTHING, NAMELY, JACKETS, BELTS, NECKWEAR, SWEATERS, SUITS, SHIRTS, BLOUSES, SKIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, MENS' AND WOMENS' BLAZERS, COATS, JACKETS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS
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Grounds for Cancellation

Abandonment	Trademark Act section 14		
Registration No	1477299	Registration date	02/23/1988
International Registration No.	NONE	International Registration Date	NONE
Registrant	GILMAR S.P.A. VIA S. ALLENDE 130 CATTOLICA, FORLI, ITALY		

Goods/Services Subject to Cancellation

Class 025.

All goods and services in the class are cancelled, namely: MEN'S AND WOMENS' CLOTHING, NAMELY, JACKETS, BELTS, NECKWEAR, SWEATERS, SUITS, SHIRTS, BLOUSES, SKIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, MENS' AND WOMENS' BLAZERS, COATS, JACKETS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS

Grounds for Cancellation

Abandonment		Trademark Act section 14	
Registration No	1850734	Registration date	08/23/1994
International Registration No.	NONE	International Registration Date	NONE
Registrant	GILMAR S.P.A. VIA MALPASSO, 723/725 47842 S. GIOVANNI IN MARIGNANO, RIMINI, ITALY		

Goods/Services Subject to Cancellation

Class 025.

All goods and services in the class are cancelled, namely: CLOTHING; NAMELY, MEN'S, WOMEN'S[AND CHILDREN'S] SUITS, COATS, [HATS, BLOUSES,] CAPS, SHIRTS, T-SHIRTS, BELTS, VESTS, SCARVES, SKIRTS, TIES, SHORTS, [KNICKERS,] BATHING SUITS, DRESSES, JACKETS, SWEATERS, [JOGGING SUITS AND LOUNGEWEAR, OVERALLS,] JEANS, [NIGHT GOWNS,] PAJAMAS, [SOCKS, STOCKINGS,] KERCHIEFS, UNDERWEAR, SHOES, [BOOTS AND SLIPPERS]

Grounds for Cancellation

Abandonment		Trademark Act section 14	
Registration No	2518973	Registration date	12/18/2001
International Registration No.	NONE	International Registration Date	NONE
Registrant	Gilmar S.p.A. Via Malpasso 723/725 47842 S. Giovanni in Marignano Rimini, ITALY		

Goods/Services Subject to Cancellation

Class 025.

All goods and services in the class are cancelled, namely: Men's and women's clothing, namely, jackets, belts,[neckties,] sweaters, suits, shirts, blouses, skirts, dresses,[hosiery,] scarves, [shawls,] men's and women's blazers, coats, jeans, jogging suits, [loungewear,] pantsuits, rainwear, shorts, [slacks, socks,]sport coats, hats, caps, gloves, kerchiefs, shoes, boots and slippers

Grounds for Cancellation

Abandonment		Trademark Act section 14	
Registration No	2909353	Registration date	12/14/2004
Registrant	Gilmar S.p.A. Via Malpasso 723/725 47048 S. Giovanni in Marignano		

	Rimini, ITALY
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Goods/Services Subject to Cancellation

Class 025. First Use: 1988/09/09 First Use In Commerce: 1989/02/01
All goods and services in the class are cancelled, namely: pants, shirts, shorts, jackets, sweatshirts, sweaters, T-shirts, blouses, sweatsuits, rainwear, coats, dresses, vests, knit tops, leotards, robes

Grounds for Cancellation

Abandonment	Trademark Act section 14		
Registration No	3029399	Registration date	12/13/2005
International Registration No.	NONE	International Registration Date	NONE
Registrant	GILMAR S.P.A. VIA MALPASSO 723/725 I-47842 S.GIOVANNI IN MARIGNANO RN ITALY		

Goods/Services Subject to Cancellation

Class 025.
All goods and services in the class are cancelled, namely: Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers

Grounds for Cancellation

Abandonment	Trademark Act section 14		
Registration No	3029400	Registration date	12/13/2005
International Registration No.	NONE	International Registration Date	NONE
Registrant	GILMAR S.P.A. VIA MALPASSO 723/725 I-47842 S.GIOVANNI IN MARIGNANO RN ITALY		

Goods/Services Subject to Cancellation

Class 025.
All goods and services in the class are cancelled, namely: Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers

Grounds for Cancellation

Abandonment	Trademark Act section 14		
Registration No	3303328	Registration date	10/02/2007
Registrant	Gilmar S.p.A. Via Malpasso 723/725 S. Giovanni in Marignano, 47842 ITALY		

Goods/Services Subject to Cancellation

Class 025. First Use: 2005/09/26 First Use In Commerce: 2005/09/26

All goods and services in the class are cancelled, namely: JACKETS, BELTS, NECKTIES, SKIRTS, BLOUSES, SHIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, COATS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, HATS, CAPS, SHOES, BOOTS

Grounds for Cancellation

Abandonment	Trademark Act section 14
Related Proceedings	The parties are engaged in a series of five opposition proceedings, consolidated under Opposition No. 91167875.
Attachments	Petition For Cancellation.pdf (13 pages)(511190 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/James L. Vana/
Name	James L. Vana
Date	12/16/2010

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ICEBREAKER LIMITED

Petitioner,

v.

GILMAR S.P.A.,

Registrant.

PETITION FOR CANCELLATION

Registrations No.: 1850734
3029399
3029400
3303328
1477299
2518973
2909353
1477298

Icebreaker Limited ("Petitioner") believes that it will be damaged by the continued registration by Gilmar, S.P.A. ("Registrant") for the marks shown in Exhibit A attached hereto ("Registrant's Marks") for use in connection with those goods ("Registrant's Goods") listed in the registrations shown in Exhibit A hereto (the "Subject Registrations"), and hereby petitions to cancel the Registrations. As grounds for its petition, Petitioner alleges as follows:

I. PARTIES

1. Petitioner is a New Zealand company, having a place of business in Wellington, New Zealand.
2. On information and belief, Registrant is an Italian company having a place of business in San Giovanni Marignano, Italy.

II. PETITIONER'S MARK

3. Petitioner is engaged in the manufacture, retail sale and distribution of a variety of apparel products ("Petitioner's Goods and Services") as set forth in the applications and

registration noted in Exhibit B hereto ("Petitioner's Applications and Registration") under the mark ICEBREAKER ("Petitioner's Mark").

4. Petitioner has filed Petitioner's Applications to register Petitioner's Marks with Petitioner's Goods and Services. An excerpt from the on-line records showing Petitioner's Applications is attached as Exhibit C hereto.

5. Registrant has filed oppositions No. 91167875, 91190567, 91190574, 91192163 and 91192164 (the "Oppositions"), opposing registration of Petitioner's Marks based on a likelihood of confusion with Registrant's Marks and has listed the Subject Registrations as support for the Oppositions.

III. REGISTRANT'S REGISTRATIONS

6. The Subject Registrations were issued between 1988 and 2007, as noted specifically in Exhibit A attached hereto.

IV. CLAIM FOR ABANDONMENT

7. On information and belief, Registrant has ceased using Registrant's Marks in commerce with Registrant's Goods, with no intent to resume use of Registrant's Marks.

8. On information and belief, Registrant has discontinued each of Registrant's Marks in commerce for a period of at least three consecutive years. Specifically, recently received deposition testimony and written discovery responses in the Oppositions support the conclusion that use of each of Registrant's Marks was discontinued, or never commenced, in commerce for such a period following the registration date for each such mark.

9. The continued registration of Registrant's Marks would prevent Petitioner from

registering Registrant's Marks, and from exercising exclusive control over the goodwill and reputation associated with Petitioner's Marks. Therefore, the continued registration of Registrant's Marks would damage and injure Petitioner.

10. Because Registrant's Marks have been abandoned, the Subject Registrations should be cancelled.

IV. REQUEST FOR RELIEF

WHEREFORE, Petitioner requests that each of the Subject Registrations be cancelled.

V. FEES

Please charge Petitioner's deposit account No. 0502278, for the \$2,400 fee for this cancellation petition.

DATED: December 16, 2010

CERTIFICATE OF SERVICE

I hereby certify that this Petition For Cancellation is being deposited with the United States Postal Service with sufficient postage as first class mail on December 16, 2010, in an envelope addressed to John C. Blattner, Butzel Long, 350 S. Main St., Ste. 300, Ann Arbor, MI 48104.

Signature: Linda Z. Martin

Print Name: Linda Z. Martin

PERKINS COIE LLP

By 

James L. Vana

Perkins Coie LLP

1201 Third Avenue, 40th Floor



Seattle, Washington 98101-3099

(206) 359-8000

Attorney for Icebreaker Limited

Exhibit A

Registrant's Registrations

<u>Reg. No.</u>	<u>Mark</u>	<u>Goods</u>	<u>Reg. Date</u>
3029399	ICE B	Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attaché cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks	12/13/05
3029400		Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers	12/13/05
1850734	ICE	Clothing, namely, men's, women's suits, coats, caps, shirts, t-shirts, belts, vests, scarves, skirts, ties, shorts, bathing suits, dresses, jackets, sweaters, jeans, pajamas, kerchiefs, underwear, shoes	8/23/94
2909353		Handbags, backpacks, fanny packs, tote bags, cosmetic cases sold empty Pants, shirts, shorts, jackets, sweatshirts, sweaters, T-shirts, blouses, sweatsuits, rainwear, coats, dresses, vests, knit tops, leotards, robes	12/14/04
3303328	ICE ICE BABY ICEBERG	Shoulder bags, purses, handbags, wallets Jackets, belts, neckties, skirts, blouses, shirts, dresses, hosiery, scarves, shawls, coats, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, hats, caps, shoes, boots	10/2/07




<u>Reg. No.</u>	<u>Mark</u>	<u>Goods</u>	<u>Reg. Date</u>
1477299		Luggage, namely, attaché cases, garment bags, suitcases, briefcases, athletic bags, duffel bags, hat boxes for travel, overnight cases, vanity cases, traveling bags, trunks, shoulder bags, key cases, purses, handbags, wallets and umbrellas	2/23/88
1477298		Men's and women's clothing, namely, jackets, belts, neckwear, sweaters, suits, shirts, blouses, skirts, dresses, hosiery, scarves, shawls, men's and women's blazers, coats, jackets, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, sports coats, hats, caps, gloves, kerchiefs, shoes, boots, and slippers	2/23/88
2518973		Luggage, trunks, traveling bags, purses of leather Men's and women's clothing, namely, jackets, belts, sweaters, suits, shirts, blouses, skirts, dresses, scarves, men's and women's blazers, coats, jeans, jogging suits, pantsuits, rainwear, shorts, sport coats, hats, caps, gloves, kerchiefs, shoes, boots and slippers	12/18/01

Exhibit B

Petitioner's Applications and Registrations



<u>App./Reg. No.</u>	<u>Mark</u>	<u>Goods/Services</u>
78683696		Outerwear, namely, muffs; footwear, namely, insulated over boots
78683671	ICEBREAKER	Outerwear, namely, muffs; footwear, namely, insulated over boots
77212966	ICEBREAKER	Distributorship services in the field of clothing, headgear and accessories; online retail store services featuring clothing, headgear and accessories; online wholesale distributorship services in the field of clothing, headgear and accessories; retail store services featuring clothing, headgear and accessories; wholesale ordering services in the field of clothing, headgear and accessories; procurement, namely, purchasing clothing, headgear and accessories, for others; trading services, namely, arranging of contractual trade services with third parties; distributorship services, home shopping services and catalogue ordering services whether through publications, electronic publications, catalogues, newsletters, direct mail, mail order or otherwise, all in relation to clothing, headgear and accessories; marketing, advertising, promotional and business advisory services, all in relation to the sale of clothing, headgear and accessories
77212963	ICEBREAKER	clothing, namely, pullovers, scarves, shirts, sweatshirts, singlets, socks, sweaters, tee shirts, underclothes, boxer shorts, jockey shorts, underpants, underwear, thermal underwear, camisoles, shorts, pants, jackets, coats, jerseys, jumpers, vests, leggings, neck warmers, and gloves; cyclist clothing, namely, shirts, shorts, leggings, and pullovers; headgear, namely, caps, hats, balaclavas
76528102	ICEBREAKER	Divesuits; fabric for use in the manufacture of clothing, footwear and headwear
1362030		Insulated footwear

Exhibit C

Copies of Petitioner's Applications and Registration

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Word Mark	ICEBREAKER
Goods and Services	IC 025. US 022 039. G & S: OUTERWEAR, NAMELY, MUFFS; FOOTWEAR, NAMELY, INSULATED OVER BOOTS
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	06.01.04 - Mountains (landscapes); Scenery with mountains 06.09.06 - Icebergs; Polar scenery; Snow-covered landscape
Serial Number	78683696
Filing Date	August 2, 2005
Current Filing Basis	1B
Original Filing Basis	1B
Published for Opposition	April 21, 2009
Owner	(APPLICANT) ICEBREAKER LIMITED CORPORATION NEW ZEALAND LEVEL 2, 7-11 DIXON STREET HOPE GIBBONS BUILDING WELLINGTON NEW ZEALAND 6140
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	James L. Vana
Description of Mark	Color is not claimed as a feature of the mark.
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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ICEBREAKER

Word Mark ICEBREAKER
Goods and Services IC 025. US 022 039. G & S: OUTERWEAR, NAMELY, MUFFS; FOOTWEAR, NAMELY, INSULATED OVER BOOTS. FIRST USE: 19840101. FIRST USE IN COMMERCE: 19840101
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Serial Number 78683671
Filing Date August 2, 2005
Current Filing Basis 1A
Original Filing Basis 1B
Published for Opposition February 10, 2009
Owner (APPLICANT) Icebreaker, Inc. CORPORATION GEORGIA P.O. Box 236, 364 Jefferson Street Clarkesville GEORGIA 30523
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record James L. Vana
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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ICEBREAKER

Word Mark ICEBREAKER

Goods and Services IC 035. US 100 101 102. G & S: Distributorship services in the field of clothing, headgear and accessories; online retail store services featuring clothing, headgear and accessories; online wholesale distributorship services in the field of clothing, headgear and accessories; retail store services featuring clothing, headgear and accessories; wholesale ordering services in the field of clothing, headgear and accessories; procurement, namely, purchasing clothing, headgear and accessories, for others; trading services, namely, arranging of contractual trade services with third parties; distributorship services, home shopping services and catalogue ordering services whether through publications, electronic publications, catalogues, newsletters, direct mail, mail order or otherwise, all in relation to clothing, headgear and accessories; marketing, advertising, promotional and business advisory services, all in relation to the sale of clothing, headgear and accessories

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 77212966

Filing Date June 22, 2007

Current Filing Basis 1B;44E

Original Filing Basis 1B;44E

Published for Opposition September 22, 2009

Owner (APPLICANT) ICEBREAKER LIMITED CORPORATION NEW ZEALAND LEVEL 2, HOPE GIBBONS BUILDING 7-11 DIXON STREET, WELLINGTON NEW ZEALAND

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record James L. Vana

Prior Registrations 1362030

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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ICEBREAKER

Word Mark	ICEBREAKER
Goods and Services	IC 025. US 022 039. G & S: clothing, namely, pullovers, scarves, shirts, sweatshirts, singlets, socks, sweaters, tee shirts, underclothes, boxer shorts, jockey shorts, underpants, underwear, thermal underwear, camisoles, shorts, pants, jackets, coats, jerseys, jumpers, vests, leggings, neck warmers, and gloves; cyclist clothing, namely, shirts, shorts, leggings, and pullovers; headgear, namely, caps, hats, balaclavas
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	77212963
Filing Date	June 22, 2007
Current Filing Basis	1B;44E
Original Filing Basis	1B;44E
Published for Opposition	September 22, 2009
Owner	(APPLICANT) ICEBREAKER LIMITED CORPORATION NEW ZEALAND LEVEL 2, HOPE GIBBONS BUILDING 7-11 DIXON STREET, WELLINGTON NEW ZEALAND
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	James L. Vana
Prior Registrations	1362030
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark ICEBREAKER
Goods and Services IC 009. US 021 023 026 036 038. G & S: divesuits
IC 024. US 042 050. G & S: fabric for use in the manufacture of clothing, footwear and headwear
Mark Drawing Code (1) TYPED DRAWING
Serial Number 76528102
Filing Date July 7, 2003
Current Filing Basis 44E
Original Filing Basis 1B;44D;44E
Published for Opposition May 24, 2005
Owner (APPLICANT) Icebreaker New Zealand Limited CORPORATION NEW ZEALAND Level 2, Hope Gibbons Building 7-11 Dixon Street Wellington NEW ZEALAND
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record James L. Vana
Priority Date May 23, 2003
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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ASSIGN Status

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TTAB Status

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Word Mark	ICEBREAKER
Goods and Services	IC 025. US 039. G & S: INSULATED FOOTWEAR. FIRST USE: 19840523. FIRST USE IN COMMERCE: 19840731
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	06.01.04 - Mountains (landscapes); Scenery with mountains 06.09.06 - Icebergs; Polar scenery; Snow-covered landscape
Serial Number	73498809
Filing Date	September 10, 1984
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	July 16, 1985
Registration Number	1362030
Registration Date	September 24, 1985
Owner	(REGISTRANT) ICEBREAKER, INC. CORPORATION GEORGIA P.O. BOX 236 364 JEFFERSON STREET CLARKESVILLE GEORGIA 30523 (LAST LISTED OWNER) ICEBREAKER LIMITED CORPORATION NEW ZEALAND LEVEL 2, 7- 11 DIXON STREET HOPE GIBBONS BUILDING WELLINGTON NEW ZEALAND 6140
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	James L. Vana
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20060119.
Renewal	1ST RENEWAL 20060119
Live/Dead Indicator	LIVE

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